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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,015	02/17/2005	Noboru Yamaji	Q86324	5025
65565 7590 02/25/2008 SUGHRUE-265550 2100 PENNSYLVANIA AVE. NW WASHINGTON, DC 20037-3213			EXAMINER KOSAR, ANDREW D	
			ART UNIT 1654	PAPER NUMBER
			MAIL DATE 02/25/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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SUGHRUE-265550
2100 PENNSYLVANIA AVE.
NW WASHINGTON, DC 20037-3213

In re Application of:
Yamaji et al.
Serial Number: 10/525,015
Filed: February 17, 2005
Attorney Docket No.: Q86324

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: PETITION DECISION
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This is in response to the petition under 37 CFR § 1.181, filed January 8, 2008, requesting that the final Office action mailed November 8, 2007 be withdrawn.

BACKGROUND

More recently, the examiner mailed a non-final Office action on June 4, 2007. At the time this non-final Office action was mailed, claims 11 and 13-17 were pending in the application. The examiner rejected claims 11 and 13-17 under 35 U.S.C. 102(b) as being anticipated by Kammer et al.

In response to the non-final Office action of June 4, 2007, applicants submitted a reply on September 4, 2007 which included arguments and amendments to the claims. Amongst the claim amendments, applicants added the following new claim:

18. (new): A method for treating osteoarthritis, caused by articular cartilage extracellular matrix degradation, which comprises administering a therapeutically effective amount of a histone deacetylase-inhibiting compound to a patient in need thereof.

The examiner subsequently mailed a final Office action on November 8, 2007. At the time this final Office action was mailed, claims 11 and 13-18 were pending. The examiner maintained the rejection of claims 11 and 13-17 under 35 U.S.C. 102(b) as being anticipated by Kammer et al. The examiner additionally set forth a new ground of rejection, rejecting claims 11 and 13-18 under 35 U.S.C. 102(b) as being anticipated by Watkins et al. In regard to this new rejection, the examiner stated "Watkins has been introduced in response to new claim 18, and it has been determined that Watkins may be appropriately applied to claims 11 and 13-17" (see page 4, final Office action of November 8, 2007).

In response to the final Office action of November 8, 2007, applicants filed this petition under 37 CFR § 1.181 on January 8, 2008, requesting that the final Office action mailed November 8, 2007 be withdrawn.

DISCUSSION

The petition and the file history have been carefully considered.

In the petition, applicants argue that the new rejection set forth by the examiner over claims 11 and 13-17 as being anticipated by Watkins et al. in the final Office action was premature. Applicants contend that while newly presented claim 18 contained embodiments not previously considered by the examiner, that claims 11 and 13-17 did not include these new limitations and hence assert that the rejection of claims 11 and 13-17 as being anticipated by Watkins et al. was a new rejection not necessitated by applicants' amendments to the claims. Applicants specifically argue:

In the present case, new claim 18 was added, but claims 11 and 13-17 were not substantively amended. Claims 11 and 13-15 were not amended at all and claims 16 and 17 were amended by inserting the article "a" before "histone deacetylase -inhibiting compound" merely to correct an informality, which did not necessitate the new grounds of rejection. Despite this, the Examiner issued a Final Office Action, dated November 8, 2007, in which the Examiner set forth a new rejection against claims 11 and 13-17 based on Watkins as mentioned above. For the first time in the Final Office Action dated November 8, 2007, the Examiner cited this new reference against claims that were not substantively amended as discussed above. Thus, Applicants' amendments have not necessitated this new ground of rejection.

Applicants cite a passage from MPEP § 706.07(a) in support of their contentions; a more detailed excerpt from the passage is provided below:

Furthermore, a second or any subsequent action on the merits in any application or patent undergoing reexamination proceedings *will not be made final if it includes a rejection, on newly cited art, other than information submitted in an information disclosure statement filed under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p), of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art...* (emphasis added)

Thus, the MPEP precisely states that in order to make a second or subsequent action final, non-amended claims must not be rejected over newly-cited prior art, even if an amended claim requires a new rejection over a newly-cited art reference, unless the newly-cited art reference was submitted in an IDS. Watkins et al. was newly cited by the examiner to reject claim 18 which contained limitations not previously considered by the examiner. In strict accordance with the MPEP, although the Watkins et al. reference is applicable to claims 11 and 13-17 under 35 U.S.C. 102(b) in addition to claim 18, the new rejection of claims 11 and 13-17 over Watkins et al. in the Office action mailed November 8, 2007 precluded the finality of said Office action.

It is thus decided that the finality of the Office action mailed by the examiner on November 8, 2007 was improper and premature because per the provisions set forth in the MPEP § 706.07(a), the rejection of claims 11 and 13-17 under 35 U.S.C. 102(b) as being anticipated by Watkins et al. was a new rejection which was not necessitated by applicants' amendments to claims 11 or 13-17.

DECISION

The petition is **GRANTED**.

This application will be forwarded to the examiner for an action not inconsistent with this decision.

Should there be any questions about this decision please contact Marianne C. Seidel, by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0584 or by facsimile sent to the general Office facsimile number, 703-872-9306.

A handwritten signature in black ink, appearing to read 'Bruce Kisliuk', with a stylized flourish at the end.

Bruce Kisliuk
Director, Technology Center 1600

PATENT APPLICATION
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q86324

Noboru YAMAJI, et al.

Appln. No.: 10/525,015

Group Art Unit: 1654

Confirmation No.: 5025

Examiner: Andrew D. KOSAR

Filed: February 17, 2005

For: AN AGENT FOR INHIBITING ARTICULAR CARTILAGE EXTRACELLULAR
MATRIX DEGRADATION

PETITION TO WITHDRAW FINALITY
UNDER 37 C.F.R. § 1.181

ATTN: Technology Director
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant submits that the final Office Action dated November 8, 2007, improperly has been made final and thus respectfully solicits withdrawal of the finality of the Office Action.

Specifically, the Examiner has raised a new ground of rejection based on a newly cited reference. The Examiner states that the rejection is necessitated by the amendments to the claims, particularly the introduction of new claim 18. The Examiner also states that Watkins, a new reference may be appropriately applied to claims 11 and 13-17, which were not amended substantively. Contrarily, the MPEP § 706.07(a) states:

a second or any subsequent action on the merits in any application or patent undergoing reexamination proceedings will not be made final if it includes a rejection, on newly cited art . . . of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art (emphasis added).

In the present case, new claim 18 was added, but claims 11 and 13-17 were not substantively amended. Claims 11 and 13-15 were not amended at all and claims 16 and 17 were amended by inserting the article "a" before "histone deacetylase –inhibiting compound" merely to correct an informality, which did not necessitate the new grounds of rejection. Despite this, the Examiner issued a Final Office Action, dated November 8, 2007, in which the Examiner propounded a new rejection against claims 11 and 13-17 based on Watkins as mentioned above. For the first time in the Final Office Action dated November 8, 2007, the Examiner cited this new reference against claims that were not substantively amended as discussed above. Thus, Applicants' amendments have not necessitated this new ground of rejection.

Since the Examiner applied the newly cited reference to claims not substantively amended, i.e., claims 11 and 13-17, Applicants submit that the final rejection is improper.

Further, since Applicants are limited in the action that can be taken after a final rejection as a matter of right, Applicants submit that making the rejection final is improper as a procedural matter for the reasons set forth above.

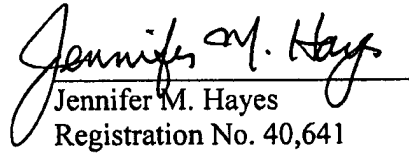
For the reasons discussed above, Applicant requests that the finality of the Office Action be withdrawn.

PETITION TO WITHDRAW FINALITY
U.S. Appln. No.: 10/525,015

Attorney Docket No.: Q86324

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account. A duplicate copy of this sheet is enclosed.

Respectfully submitted,


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WASHINGTON DC SUGHRUE/265550

65565

CUSTOMER NUMBER

Date: January 8, 2008